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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,446	03/09/2004	Wayne Cohen	A33956-A 072708.0362	2412

30873 7590 06/02/2006

DORSEY & WHITNEY LLP  
INTELLECTUAL PROPERTY DEPARTMENT  
250 PARK AVENUE  
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EXAMINER
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MCDONALD, SHANTESE L

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 06/02/2006

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/796,446  
Filing Date: March 09, 2004  
Appellant(s): COHEN, WAYNE

**MAILED**  
**JUN 02 2006**  
**GROUP 3700**

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Gary Abelev  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 2/23/06 appealing from the Office action mailed 11/17/05.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,056,464	Cohen	5-200
5,169,305	Kee	12-1992

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohen in view of Kee.

Cohen teaches a maraca in combination with a pen, and the Kee reference teaches a bottle opener in combination with a lighter. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make a combination tool of a maraca or a shaker with a bottle opener since both references teach combining tools, and the Kee reference teaches combining a bottle opener with another device. Both the maraca pen of Cohen and the lighter/bottle cap remover are novelty items. It would have been obvious to provide the novelty pen/maraca of Cohen with a bottle cap remover so as to make the novelty maraca more versatile and desirable in view of the teaching of the Kee reference which suggests that it is old

notoriously old to place bottle cap openers on various implements to make them more versatile.

#### **(10) Response to Argument**

The Appellant argues that there is absolutely no teaching, suggestion, motivation or incentive to combine the Cohen patent with the Kee patent to teach or suggest the Appellant's invention. The Appellant states that the Cohen patent is a "new novelty attachment for a pen or pencil that includes a hollow shell with sounding beads which, when attached to the pen or pencil can act as a maraca or rattle". (Cohen, col.1, lines 6-9). The Examiner points out that the Cohen reference describes in the presently cited invention, as well as previous inventions that maracas are a novelty item. It is a well known fact and teaching in the art to combine novelty items. The Examiner notes, as an example of extrinsic evidence, that Liquori et al. (6,943,670), states that lighters, ballpoint pens and bottle openers are novelty items, (col. 1, lines 14-20). The Cohen reference teaches a maraca combined with a ballpoint pen, which is a further example of the combination of novelty items. Therefore there is motivation to combine the maraca with the bottle opener, since the bottle opener has been taught, and shown through extrinsic evidence, to be considered a novelty item. (For further clarification, the Examiner notes that the Liquori et al. (6,943,670) patent is not being cited as a reference, but merely relied on for extrinsic evidence.)

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

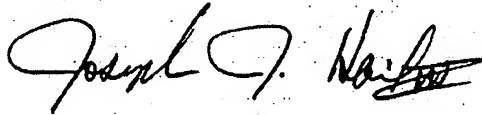
Respectfully submitted,

Shantese McDonald

Conferees:

Joseph Hail

Derris Banks

Handwritten signatures of Joseph Hail and Derris Banks. The signature for Joseph Hail is written in cursive and appears to be 'Joseph Hail'. The signature for Derris Banks is also in cursive and appears to be 'Derris Banks'.